

REMARKS

Claims 1 and 3-10 are all the claims pending in the application.

Claim 1 has been amended to incorporate the features of original claim 2.

Claim 2 has been cancelled.

Claims 3 and 6 have been amended to change its dependency from claim 2 to claim 1.

Entry of the amendments and reconsideration of the present application are respectfully requested in view of the following remarks.

I. Claim Rejections - 35 USC § 102

A. The Examiner's Position

The Examiner has rejected claims 1 and 8-10 under 35 U.S.C. 102(b) as being anticipated by Tsuchiya et al (5,882,844).

The Examiner has further rejected claims 1, 8, and 9 under 35 U.S.C. § 102(b) as being anticipated by Takemura et al (5,691,396).

B. Applicants' Response

To distinguish over Tsuchiya et al and Takemura et al, Applicants have amended claim 1 to recite the features of original claim 2. Neither reference teaches or suggests the claimed positive resist composition wherein the alkali-soluble polysiloxane resin has a siloxane unit containing an alkali-soluble group and a siloxane unit containing an alkali-insoluble group, the alkali-insoluble group having no acid-decomposable group.

In view of the above, Applicants respectfully submit that the 102(b) rejections have been overcome.

II. Claim Rejections - 35 USC § 103

A. The Examiner's Position

The Examiner has rejected claims 1-6, 8, and 9 under 35 U.S.C. 103(a) as allegedly being unpatentable over Tokutake et al (JP 04-130324 and its English abstract) in view of Honda (5,565,304).

The Examiner states that Tokutake teaches a positive type resist having an alkaline-soluble silicone polymer having a repeating unit of $(HO-C_6H_4CH_2-SiO_{3/2})$, which is the presently claimed siloxane unit containing an alkali-soluble group (hydroxyl group), and further having a repeating unit of $(C_6H_4-CH_2-SiO_{3/2})$, which is the presently claimed siloxane unit containing an alkali-insoluble group (an aralkyl group) having no acid-decomposable group. The Examiner further states that Tokutake teaches a 1,2-naphthoquinone diazide group containing compound, which is allegedly the presently claimed photoacid generating compound (B). The Examiner admits that the English translation of the Tokutake abstract does not disclose the claimed element (C).

The Examiner cites Honda for teaching an alkaline dissolution inhibitor containing acid-cleavable groups, which is allegedly the claimed element (C).

According to the Examiner, motivation to combine the teachings of Tokutake and Honda can be found in the facts that Honda teaches the addition of dissolution inhibitors, such as claimed element (C), to photoresist compositions having an alkali-soluble resin, such as claimed element (A), and a photoacid generating compound, such as claimed element (B) and that Tokutake teaches a photoresist composition having an alkali-soluble resin, such as that claimed in claim 2, and a photoacid generating compound. That is, Honda teaches the addition to dissolution inhibitors to compositions such as those taught by Tokutake.

Second, the Examiner has rejected claims 1-10 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Ogata et al (JP 2001-51422 and its machine-assisted English translation provided by the Japanese Patent Office) in view of Honda.

B. Applicants' Response

Applicants respectfully traverse for the following reasons.

First, Applicants submit that the 1,2-naphthoquinone diazide group containing compound as taught by Tokutake is not an acid generator as claimed in the present invention. Therefore, Tokutake does not teach or suggest claimed element (B), and, thus, cannot teach a composition having an alkali-soluble resin and a photoacid generating compound, to which a dissolution inhibitor of Honda may be added, as stated by the Examiner above, regarding motivation to combine the references.

Furthermore, Tokutake does not disclose claimed element (C), and Honda does not disclose the claimed element (A). Therefore, there is no motivation to combine both references. Applicants respectfully submit that the Examiner has not shown motivation to combine Tokutake and Honda in a manner required to meet the claims.

Second, regarding the rejection over Ogata, Applicants hereby submit a certified English translation of the priority document, Japanese application No. 2000-240871 filed August 9, 2000. The cited Ogata reference is available under 35 U.S.C. § 102 (a), since it has a publication date of February 23, 2001. However, the priority date of the present application is August 9, 2000, which predates the reference date of Ogata. By submitting the certified English translation of the priority document, Applicants respectfully submit that Ogata is removable as a reference and request that Ogata be removed and that the rejection based upon Ogata be withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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